

REMARKS

The final Office Action mailed October 13, 2010, has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Rejection(s) Under 35 U.S.C. § 102

Claims 55-60 and 95-100 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. pub. no. 2003/0176851 to Bass (hereinafter, "Bass").

Claim 55 was amended in the Amendment of April 6, 2010, to recite "cutting, using a blade, fat that has extruded through said hole on a side of said surface opposite said fatty tissue." (Emphasis added) Bass simply does not disclose cutting using a blade. The final Office Action characterizes the operation of the electrocautery member as "cutting removing or shaving," resurrecting canceled claim 57 to quote therefrom "said step of cutting said fat comprises cutting said fat with an electrocautery cutting element," and reasoning, in the Response to Arguments and in paragraph #4 (page 3, lines 8-12), that Bass' use of an electrocautery element anticipates claim 55. However, this reasoning simply does not address the express recitation of the use of a blade. Applicants respectfully request that recital of the claimed use of a blade be given due consideration in view of the mandate that a claim is anticipated under 35 U.S.C. § 102 only if each and every claim element (such as use of a blade) is found, either expressly or inherently described, in a single prior art reference.¹ As previously repeatedly explained, for example in the Background section of the disclosure, in the Amendment of April 6, 2010, and again in the Reply to Notice of Non-Compliant Amendment filed August 2, 2010, the use of an electrocautery element is different from the use of blade. Factors such as cost, hygiene, and impact on the tissue involved underscore this difference.

Claims 56-60 and 92-94 depend directly or indirectly from claim 55 and are patentable over Bass at least by virtue of this dependency.

¹ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claims 95 and 104 respectively recite cutting using a shearing member and a scraper. This is not disclosed in Bass, which, as explained above, uses an electrocautery member, and the final Office Action is silent on the use of a shearing member and a scraper versus the use of an electrocautery member. Claims 96-103 and 105-112 variously depend directly or indirectly from claims 95 and 104 and are patentable over Bass at least by virtue of this dependency.

Rejection(s) Under 35 U.S.C. § 103(a)

Claims 92-94 and 101-103 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bass and claims 104-112 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bass in view of U.S. pat. no. 6,071,260 to Halverson (hereinafter, “Halverson”).

Claims 92-94 and 101-103 variously depend, directly or indirectly, from the base claims addressed above. Halverson fails to remedy the above-mentioned shortcomings of Bass with respect to the base claims. Accordingly, claims 92-94 and 101-103, which by definition include all the limitations of the base claims, are patentable over the combination of these references.

Conclusion

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

Please charge any additional required fees, including those necessary to obtain extensions of time to render timely the filing of the instant Reply to Office Action, or credit any overpayment not otherwise credited, to our deposit account no. 50-3557.

Respectfully submitted,
NIXON PEABODY LLP

Dated: February 14, 2011

/Khaled Shami/
Khaled Shami
Reg. No. 38,745

NIXON PEABODY LLP
P.O. Box 60610
Palo Alto, CA 94306
Tel.: (650) 320-7700
Fax: (650) 320-7701